THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TOMOYA KITAZUME, TAKASHI YAMAZAKI and KENJI MIZUTANI

Appeal No. 1996-0672
Application No. 08/164,774[1]

HEARD: September 16, 1999

Before METZ, JOHN D. SMITH and LIEBERMAN, Administrative Patent Judges.

JOHN D. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal pursuant to 35 U.S.C. § 134 from the final rejection of claims 1, 2, 4, and 5.

A copy of appealed claim 1 is reproduced in an attached appendix to this decision.

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[1] Application for patent filed December 10, 1993. According to the appellants, the application is a continuation-in-part of Application No. 07/949,104, filed August 31, 1992, now abandoned.

The sole reference relied upon by the examiner is:

Yamazaki et al. (Yamazaki) “Chiral Trifluoromethylated 2-Butenolides for the Construction of 6-Deoxy-6,6,6-trifluorosugars”, J. Chem. Soc., Chem. Commun., pp. 55-57, 1992.

The appealed claims stand rejected under 35 U.S.C. § 102(b) as anticipated by, or in the alternative, under 35 U.S.C. § 103 as obvious over Yamazaki.

We cannot sustain the stated rejections.

The subject matter on appeal is directed to certain optically active fluorinated compounds of the general formula shown in appealed claim 1. These compounds are described as useful, inter alia, as “raw materials” for ferroelectric liquid crystals, i.e., liquid crystalline materials comprising at least one chiral center and displaying a ferroelectric (chiral smectic) phase.

Appellants do not dispute the examiner’s factual determination that compound **13** disclosed at page 56 of Yamazaki anticipates (35 U.S.C. § 102) or alternatively renders obvious (35 U.S.C. § 103) the herein claimed compounds. Appellants’ basic argument against the prior art

rejections based on Yamazaki is that Yamazaki[2] is not available as prior art against the appealed claims. On the other hand, the examiner contends that the present continuation-in-part application is not entitled to the benefit of the filing date of the parent application[3] under 35 U.S.C. § 120 (and implicitly the benefit of the foreign priority document[4] under 35 U.S.C. § 119) because, according to the examiner, the parent application does not comply with the "how to use" requirements of 35 U.S.C. § 112, first paragraph. The examiner thus contends that the effective

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[2] The month of Yamazaki's 1992 publication date is not listed.

[3] The parent application 07/949,104 was filed on August 31, 1992 by coinventors Tomoya Kitazume, Takashi Yamazaki, and Kenji Mizutani. Based on a disclaiming declaration filed under 37 CFR § 1.132 executed by the four listed authors (including the above three coinventors) of the Yamazaki reference indicating that coauthor Mitsunori Takeda is not a coinventor of the subject matter described in the parent application, the examiner withdrew the stated prior art rejections over Yamazaki (the rejections were premised on the contention that the Yamazaki reference qualified as prior art under 35 U.S.C. § 102(a)). See appellants' response filed July 12, 1993 and the examiner's final rejection entered September 29, 1993 in the parent application.

[4] Japanese foreign priority document 4-015683 was filed on January 31, 1992.

filing date of the presently claimed invention is the filing date of this continuation-in-part application ,i.e., December 10, 1993, and , therefore, the examiner argues that the 1992 Yamazaki reference qualifies as prior art under 35 U.S.C. § 102(b). Thus, the dispositive issue generated by the examiner's rejections in this appeal is whether or not the originally filed parent application complies with the "how to use" requirement of 35 U.S.C. § 112, first paragraph. Essentially for the reasons and arguments set forth in appellants' brief and the evidence in support of appellants' arguments, we answer this question in the affirmative. We add the following brief comments for emphasis only.

The examiner contends that appellants' statement in the last full paragraph of page 1 of the specification that the claimed optically active compounds are "useful" as a "raw material" for ferroelectric liquid crystals is not a disclosure of "specific definite utility within the meaning of 35 U.S.C. § 101" and is thus an inadequate teaching of "how to use the claimed invention within the meaning of 35 U.S.C. § 112, first paragraph." See the answer at page 3.

In response to the

examiner's stated rejection, appellants argue that one of ordinary skill in this art would have understood from the originally filed specification that the claimed optically active chiral "raw materials" are starting materials useful in making more complicated ferroelectric liquid crystals and in providing doped liquid crystalline compositions. Appellants' arguments are supported, inter alia, by a declaration from an "experienced synthetic organic chemist" and researcher "in the field of liquid crystals", Dr. Jawad Naciri. In his declaration at pages 7 and 8, Dr. Naciri states that based on his knowledge of liquid crystals in general, he was "immediately able to envision" three specific classes of liquid crystalline compounds which may be produced by substituting the claimed compounds for existing 6-membered ring-containing liquid crystalline compounds involving "only, simple routine synthetic organic reactions well within the skill of a person having only ordinary skills in the liquid crystalline field as of January, 1992." At page 8 of Dr. Naciri's declaration, he further states that one of ordinary skill in this art would have also immediately envisioned the use of the claimed compounds as low molecular weight chiral

dopants useful for inducing desirable properties in existing liquid crystals and would have been "immediately able to use these compounds in the laboratory." The Naciri declaration is also supported by corroborating literature articles attached thereto. While ignoring the factual basis supporting Dr. Naciri's opinions, the examiner simply and improperly dismissed the Naciri declaration as an opinion which "does not add anything new to the original disclosure in the parent application." See the answer at page 4. Particularly based on the Naciri declaration and the supporting literature of record, we agree with appellants that the originally filed parent application complies with the "how to use" requirement of
35 U.S.C. § 112, first paragraph. Thus we find that appellants are entitled to the benefit of the filing date of their parent application. Accordingly, we also find that the applied Yamazaki reference is not available as prior art against the appealed claims. Therefore, the examiner's stated art rejections based on Yamazaki are not sustained.

The decision of the examiner is reversed.

REVERSED

ANDREW H. METZ Administrative Patent Judge	)
JOHN D. SMITH Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
PAUL LIEBERMAN Administrative Patent Judge	)

jrg

APPENDIX

1. An optically active trifluoromethyl substituted compound represented by the general formula (I):

or

wherein * represents an asymmetric carbon atom.

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